

Application No. : 10/635,706
Filed : August 5, 2003

REMARKS

Claims 1 – 31 were pending in the application. By this paper, Applicant has amended Claims 2 – 4, 17 – 19, and 24. Accordingly, Claims 1 – 31 are presented for examination herein.

§112 Rejections

Claims 28 – 31 – Per page 2, Par. 2, Claims 28 – 31 stand rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. Specifically, the Examiner alleges that the “*specification does not describe “a first substantially asynchronous serialized protocol” and “a second substantially isochronous serialized protocol”*”. Applicant respectfully traverses the Examiner’s assertion and asserts support for the aforementioned language is replete throughout Applicant’s specification and can be found, *inter alia*, at Pars. [0034] – [0035] of Applicant’s specification as filed.

The Examiner acknowledges that the specification teaches two different protocols on page 2, Par. 2 of the Office Action (Applicant assumes the Examiner is acknowledging the various references made to isochronous and asynchronous communication). Applicant also submits that both the isochronous and asynchronous protocols are utilized in the context of a serial bus system. It therefore appears then that the Examiner is relying on the fact that, as stated by the Examiner, the “*terminologies used in the claims are not used in the specification*”.

Applicant respectfully submits that 35 U.S.C. 112, first paragraph, does not require Applicant to only use specific terminologies present in the specification, and further submits that Applicant’s terminology would convey to one skilled in the relevant art that Applicant was in possession of the claimed invention. **See also MPEP § 2163 et seq.**

Moreover, in the exemplary embodiment (although the aforementioned claims are in no way so limited) of IEEE Std. 1394a and 1394b, it is well known to those of ordinary skill that these are serial bus protocols with specific synchronicity characteristics. Hence, these references in the specification provide explicit support for Applicant’s claim language. By analogy, Applicant’s specification might describe specific types or species of fasteners (e.g., bolt, cap screw, rivet), with a claim reciting the broader genus (i.e., fasteners). Under such scenario, Applicant would not have to explicitly state that a bolt and cap screw have “threads” in order to meet the written description requirement; this is inherent in the described species and well known to those of ordinary skill in the fastener arts.

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Accordingly, Applicant respectfully requests that the Examiner's Section 112 rejections of Claims 28-31 be withdrawn.

Per page 2, Par. 4, Claims 2, 3, 8 – 15, and 17 – 28 stand rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Each of these rejections will be discussed in turn.

Claims 2, 3, 17 – 19 – The Examiner alleged that the subject of the functions “determine”, “communicate”, and “performing the acts of” was not clear thereby rendering these Claims indefinite. Applicant has herein amended Claims 2, 3, and 17 – 19 so that they now read in pertinent part: “*wherein said instructions when executed*”. Applicant submits that the aforementioned amendment addresses the Examiner's concerns, and overcomes the Examiner's rejection.

Claim 4 – Per the Examiner's suggestion, Applicant has herein amended Claim 4 to correct the deficiency highlighted by the Examiner.

Claims 18 and 19 – Per the Examiner's suggestion, Applicant has herein amended Claims 18 and 19 to correct the deficiency highlighted by the Examiner.

Claim 24 – Applicant has herein amended Claim 24 so that it now reads: “...*said device comprising apparatus to determine and communicate...*” Applicant submits that the aforementioned amendment renders the language of Claim 24 definite, and overcomes the Examiner's rejection.

§101 Rejections

Claims 2, 3 and 8 – 15 – Per page 3, Par. 5, Claims 2, 3 and 8 – 15 stand rejected under 35 U.S.C. 101 as the Examiner alleges the claimed invention is directed to non-statutory subject matter. While Applicant believes the Claims as previously presented comprise statutory subject matter, Applicant has herein amended Claims 2 and 3 per the Examiner's suggestion in order to

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advance prosecution of the present case. Applicant submits that the aforementioned amendments satisfies the requirements of 35 U.S.C. 101 and comprise statutory subject matter.

Double Patenting

5 Per the Office Action, Claims 1 – 31 appear to stand rejected on the grounds of non-statutory double patenting over U.S. Patent No. 6,891,848. Applicant submits herewith a duly executed terminal disclaimer in compliance with 37 CFR 1.321, which Applicant submits overcomes the Examiner's double-patenting rejection.

10 *§103 Rejections*

Per page 5, Par. 9, Claims 1 – 31 stand rejected under 35 U.S.C. 103(a) as being unpatentable over Stone et al. (U.S. Patent No. 6,519,657, hereinafter "Stone"). Applicant respectfully traverses the Examiner's contention that the combination of Stone with the knowledge that an S100 Alpha format packet contains no speed code renders Applicant's various
15 claimed inventions obvious, on at least two (2) separate and distinct grounds. First, Applicant submits that the combination of Stone with Applicant's admitted prior art does not teach each and every limitation present in Applicant's Claims. Second, Applicant submits that the Examiner's combination of Stone with Applicant's admitted prior art is, in the present case, an improper combination of references. See e.g. MPEP § 2143 et seq.

20 First, the Examiner states: "*it would have been obvious for one of ordinary skill in the art at the time of the invention to implement the Stone's teaching by not specifically including the speed information when the node has a connection to a legacy link layer as clearly taught in the prior art.*" However, Applicant's admitted prior art has not taught what the Examiner alleges. In fact, Applicant's discussions of the prior suggest something quite different. While Applicant has
25 admitted that S100 Alpha format packets contain no speed codes, Applicant has also stated at Pars. [0018] – [0019] that prior art systems merely shielded S100 rate nodes from data traffic with other non S100 rate nodes by issuing null packets. Applicant **has not** admitted omitting speed information when the node has a connection to a legacy link layer; rather Applicant has only acknowledged that S100 Alpha format packets do not contain speed codes. Hence, it is
30 Applicant's view that each and every limitation has not been taught by the combination of prior art references as alleged by the Examiner.

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Second, assuming arguendo that the Examiner's assertion was correct (i.e. that Applicant's admitted prior art and Stone teach each and every limitation present in Applicant's Claims) which Applicant has herein previously traversed, the proposed combination would respectfully still be improper. Namely, as is well established in the law, the proposed
5 modification by the Examiner of the prior art references cannot change the principle of operation of the prior art reference, otherwise the proposed modification is improper. See MPEP § 2143.01. Here, the proposed modification proffered by the Examiner would clearly change the principle of operation of Stone. Stone teaches at Col. 8, lines 46 – 53, that:

10 *"...the border node 250 issues a self-ID packet with added information to convey the presence of the active 1394a node 804 to the 1394b network 270. For example, the border node 250 may set the second least most significant bit in self-ID packet one 906. In other embodiments, other reserved bits 920 could be used. The present invention is well suited to using either a 1394-1995 self-ID packet or*
15 *a 1394a self-ID packet."*

In other words, Stone already has a mechanism for identifying hybrid buses. The Examiner's proposal would change the principle of operation of the teachings of Stone, in essence by obviating the mechanism in Stone altogether for conveying the presence of 1394a
20 nodes in a 1394b network.

Based on the foregoing, Applicant respectfully submits that Claims 1 – 31 distinguish over the prior art, including the teachings of Stone for at least those reasons provided above.

Other Remarks

25 Applicant hereby specifically reserves all rights of appeal (including those under the Pre-Appeal Pilot Program), as well as the right to prosecute claims of different scope in another continuation or divisional application.

Applicant notes that any claim cancellations or additions made herein are made solely for the purposes of more clearly and particularly describing and claiming the invention, and not for
30 purposes of overcoming art or for patentability. The Examiner should infer no (i) adoption of a position with respect to patentability, (ii) change in the Applicant's position with respect to any claim or subject matter of the invention, or (iii) acquiescence in any way to any position taken by the Examiner, based on such cancellations or additions.

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Furthermore, any remarks made with respect to a given claim or claims are limited solely to such claim or claims.

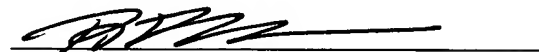
If the Examiner has any questions or comments which may be resolved over the telephone, he is requested to call the undersigned at (858) 675-1670.

Respectfully submitted,

GAZDZINSKI & ASSOCIATES

Dated: April 12, 2007

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